

REMARKS

This Amendment is being submitted in response to the Official Action dated 16 March 2005. Claim 3 and 13 are canceled. Claims 1, 2, 4-12 and 14 are amended. Claims 15 and 16 have been added as new claims. Thus, claims 1, 2, 4-12, 14-16 are pending.

The Examiner objected to the drawings under 37 CFR 1.83(a) because the claimed features “textured inner surfaces” and “rivets” must be shown in the drawings or canceled from the claim(s). Claims 3 and 13 are herein canceled to cancel the “textured inner surfaces” and “rivets” features.

The Examiner rejected claims 1, 4, and 7 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 1,428,758 to Cowles (nursing bottle supporting frame). Claims 1, 4, and 7 have been amended to limit the bottle holding apparatus to “soft drink” bottles, and to specifically recite that a first cylindrical section “conforming to a soft drink bottle shoulder for insertion of said soft drink bottle there through” and a second cylindrical section “conforming to a soft drink bottle base for insertion of said base therein”. Cowles ‘758 discloses a nursing bottle supporting frame without these limitations and thus claims 1, 4, 7 are now patentably distinguished.

The Examiner also rejected claims 1, 4, 6, and 7 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,961,112 to Didion (milk bottle holder). Claims 1, 4, and 7 have been amended to limit the bottle holding apparatus to “soft drink” bottles, and to specifically recite that a first cylindrical section “conforming to a soft drink bottle shoulder for insertion of said soft

drink bottle there through” and a second cylindrical section “conforming to a soft drink bottle base for insertion of said base therein”. Didion ‘112 discloses a nursing bottle supporting frame without these limitations and thus claims 1, 4, 7 are now patentably distinguished.

Additionally, the Examiner rejected claims 1, 2, 4, 7, 8 and 9 under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,394,304 issued to Bohne et al. (paint can holder). Claims 1, 2, 4, 7-9 have been amended to limit the bottle holding apparatus to “soft drink” bottles, and to specifically recite that a first cylindrical section “conforming to a soft drink bottle shoulder for insertion of said soft drink bottle there through” and a second cylindrical section “conforming to a soft drink bottle base for insertion of said base therein”. Accordingly, claims 1, 4, 7 are now likewise patentably distinguished.

The Examiner rejected claims 3 and 5 under 35 U.S.C. 103(a) as being unpatentable over the Bohne et. al ‘304 reference in view of U.S. Patent 5,335,954 issued to Holub et al. According to the Examiner, Holub et. al shows a cylindrical section having a textured inner surface and slightly tapered sidewalls for securely engaging the outer surface of a bottle or the like. The Examiner contends that it would have been obvious at the time the invention was made to texture the inner surfaces of the Bohne et al. ‘304 device’s cylindrical sections and slightly taper the bottom cylindrical section as taught by Holub et al. ‘954 reference to create a more secure grip on the container being held. The Examiner is improperly piecing together features found in separate prior art references where there is no suggestion or motivation to combine them. Thus, the combination is improper and the Examiner has failed to make a *prima facie*

case of obviousness. It is well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. *See In re Kamm and Young*, 17 USPQ 298, *affd.* (Court held that "[t]he rejection here runs afoul of a basic mandate inherent in section 103 - that a piecemeal reconstruction of the prior art patents in the light of appellants disclosure shall not be the basis for a holding of obviousness.) The Holub et al. '954 reference, which discloses a paint can holder and the Bohne et al. '304 reference, which shows a propane bottle carrier are not analogous art and neither teach nor suggest the desirability of merging themselves for the purpose of creating a bottle holder that has a second cylindrical section with an inwardly tapered inner surface. Therefore, this piecemeal combination is improper. Claim 3 has been canceled. Even if the combination were proper, it does not result in the invention as claimed. Both the Bohne et al. '304 device and the Holub et al. '954 device have a bottom base which is necessary for holding a propane bottle and paint can, respectively. The present invention does not require this bottom base. In fact, claim 5 as amended states, "[t]he soft drink bottle holding apparatus according to claim 1 wherein said second cylindrical section further comprises an inwardly tapered inner surface," and this tapering of the second cylindrical section's inner surface is what holds up the bottle, not a bottom base. Furthermore, claim 5 has been amended to limit the bottle holding apparatus to "soft drink" bottles and neither the individual references, Bohne et al. '304 and Holub et al. '954, nor their combination suggest the soft drink bottle holding apparatus claimed. Thus, claim 5 is patentably distinguished.

The Examiner also rejected claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over the Bohne et al. '304 reference in view of U.S. Patent No. 4,896,913 issued to

Kennedy. The Examiner contends that the Kennedy '913 reference shows a bottle holding apparatus made of plastic material which can be molded or manufactured by any known plastic manufacturing process. The Kennedy '913 patent discloses a releasable self locking handle for wide body, narrow neck containers. As stated *supra*, the Bohne et al. '304 reference discloses a propane bottle carrier. Again, the Examiner is improperly piecing together features found in separate prior art references where there is no suggestion or motivation to combine them. The Examiner asserts that the suggestion/motivation to combine these references is to manufacture the Bohne et al. '302 holder as taught by the Kennedy '913 reference to obtain the invention as claimed in claims 10 and 11. As maintained above, the present invention itself cannot be used to find the suggestion/motivation in the prior art. See In Re Kotzab, 217 F.3d 1365-69, 55 USPQ2d 1313-1316 (Fed. Cir. 2000). Hindsight is 20-20, however the present invention cannot be viewed through it when analyzing patentability of claims. Pursuant to section 103(a) the mind must be cast back to the time of the invention and only the referenced prior art and the wisdom then-accepted in the field can be used to analyze whether the claims are obvious. See In Re Kotzab, 217 F.3d 1365-69, 55 USPQ2d 1313-1316 (Fed. Cir. 2000). Thus, the combination is improper and the Examiner has failed to make a *prima facie* case of obviousness. It is well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. See In re Kamm and Young, 17 USPQ 298, *affd.* (Court held that "The rejection here runs afoul of a basic mandate inherent in section 103 - that a piecemeal reconstruction of the prior art patents in the light of appellants disclosure shall not be the basis for a holding of obviousness.") The Kennedy '913 patent and the Bohne et al. '304 patent are not analogous art

and neither teach nor suggest the desirability of merging themselves for the purpose of creating a bottle holding apparatus molded as a unitized assembly using a bonding agent. This piecemeal combination is improper.

Even if the combination were proper, it does not result in the invention as claimed.

The Bohne et al. '304 device has a bottom base which is necessary for holding a propane bottle and the Kennedy '913 device is a self-locking handle device which holds a bottle via a lock-ring that secures around a narrow-neck container. The present invention does not require a bottom base or a lock-ring to hold a bottle. Furthermore, claims 10 and 11 have been amended to limit the bottle holding apparatus to "soft drink" bottles and neither the individual references, Bohne et al. '304 and Kennedy '913, nor their combination suggest the soft drink bottle holding apparatus claimed. Therefore, claims 10 and 11 are patentably distinguished.

The Examiner further rejected claims 12 and 13 under 35 U.S.C. 103(a) being unpatentable over the Bohne et. al '304 reference in view of U.S. Patent No. 395,409 issued to Waters. The Examiner contends that the Waters '409 reference shows a container holding device formed of metal cylindrical bands and metal struts riveted together during the assembly thereof. The Examiner further contends that it would have been obvious to form the cylindrical sections and struts of the Bohne et. al '304 apparatus out of metallic materials attached together through rivets as taught by the Waters '409 reference. Again, the Examiner is improperly piecing together features found in separate prior art references where there is no suggestion or motivation to combine them. The Waters '409 patent discloses a reversible tumbler holder. On the contrary, the Bohne et al. '304 patent discloses a propane bottle carrier. These two references are not analogous art and no one would look to a device for holding tumblers/cups/glasses (Waters '409

device) or a propane bottle carrier (Bohne et al. '304 device) when manufacturing a soft drink bottle holding apparatus as claimed in claim 12. Claim 13 has been canceled. Since there is no suggestion or motivation to combine the Bohne et al. '304 patent with the Waters '409 patent, the combination is improper and the Examiner has failed to make a *prima facie* case of obviousness for claim 12.

Even if the combination were proper, it would not yield the invention as claimed in claim 12. Both the Bohne et al. '304 device and the Waters '409 device have a bottom base which is necessary for holding a propane bottle and tumbler, respectively. The present invention does not require a bottom base, but only two cylindrical sections that conform to the soft drink bottle, one at the shoulder and one at the base for insertion of said soft drink bottle there through. The cylindrical sections encircle and cradle the bottle but do not cover it. This configuration is much more efficient than the prior art as it minimizes materials costs and provides tremendous manufacturing economy. The two cylindrical sections are aligned axially for grasping and dispensing the contents of the soft drink bottle. Note also that claim 12 is specifically amended to limit the bottle holding apparatus to "soft drink" bottles and neither the individual references, Bohne et al. '304 and Waters '409, nor their combination suggest the soft drink bottle holding apparatus claimed. Therefore, claim 12 is patentably distinguished.

Also, the Examiner rejected claim 14 under 35 U.S.C. 103(a) as being obvious over the Bohne et. al '304 reference in view of U.S. Patent No. 5,816,631 to Kochan. The Examiner argues that it would have been *obvious* to provide advertisement, as taught by the Kochan '631 reference, to the cylindrical sections of the Bohne et. al invention. The Examiner is again improperly piecing together features found in separate prior art references where there is no

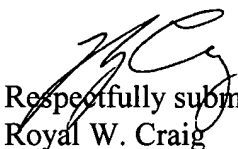
suggestion or motivation to combine them. The Kochan '631 patent discloses a removable bottle handle for soft drink bottles, while the Bohne et al. '304 patent discloses a propane bottle carrier. These two references are not analogous art and no one would look to a device for holding soft drink bottles (Kochan '631 device) in connection with a propane bottle carrier (Bohen et al. '304 device). Since there is no suggestion or motivation to combine the Bohne et al. '304 patent with the Kochan '631 patent, the combination is improper and the Examiner has failed to make a *prima facie* case of obviousness for claim 14.

Even if the combination were proper, it does not result in the invention as claimed. The Bohne et al. '304 device has a bottom base which is necessary for holding a propane bottle and the Kochan '631 bottle handle requires the user to apply pressure on the handle to clamp it around a bottle. The present invention does not require a bottom base or pressure application by the user to hold a bottle. Furthermore, claim 14 has been amended to limit the bottle holding apparatus to "soft drink" bottles and neither the individual references, Bohne et al. '304 and Kochan '631, nor their combination suggest the soft drink bottle holding apparatus claimed. Hence, claim 14 is patentably distinguished.

Claims 15 and 16 have been added to show examples of the "soft drink" bottles that the claimed soft drink holding apparatus may be used with. Furthermore, this demonstrates that the "soft drink" limitation in amended claim 1 (and all subsequent depending claims) is a structural difference over the prior art. Applicant respectfully submits that no new matter has been introduced in claims 15 and 16, nor was such the intent of Applicant. The specification supports claims 15 and 16, since 2-liter and 3-liter bottles are disclosed (on page 1, line 19) as the type of bottles that the claimed soft drink bottle holding apparatus is to hold.

In view of the above, pending claims 1, 2, 4-12 and 14 are believed to avoid all the rejections set forth in the Official Action. Additionally, claims 15 and 16 have been added and are pending. The case should be in allowance. A Notice to this effect is respectfully requested, and the Examiner is invited to call the undersigned at 410.385.2383 to discuss any remaining issues.

* * *


Respectfully submitted,
Royal W. Craig
Reg. No. 34,145
(410) 385-2383
Attorney for Applicant

Date June 16, 2005

Law Offices of Royal W. Craig, P.C.
10 North Calvert Street
Suite 153
Baltimore, Maryland 21202